

### REMARKS

Claims 1-20 were pending in the present application, all of which stand rejected. Claims 2 and 12 have been cancelled. Claim 1 has been amended for clarity and to include features originally recited in claim 2. Claims 3 and 7-9 have been amended to depend from claim 1 rather than claim 2. Claim 10 has been amended for clarity and to include features originally recited in claim 12. New claim 21 has been added. New claim 21, directed to a computer system, is supported at least by original method claim 15, Figure 2, and Figure 3.

Accordingly, claims 1, 3-11, and 13-21 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

### *Rejections under 35 U.S.C. § 103*

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Garnett et al. 2005/0047098 A1.

### **Claims 1 and 3-9**

In order to show a *prima facie* case of obviousness, each and every feature of the claims must be taught or suggested by the prior art. See MPEP §2143.03. Garnett et al. does not teach or suggest a computer system comprising a computer rack, first and second stacks of computers, and first and second cooling plenums, in which “a partially overlapping portion of the back side of the first stack faces a partially overlapping portion of the back side of the second stack, an exposed portion of the first stack faces the first cooling plenum, and an exposed portion of the second stack faces the second cooling plenum,” as recited in claim 1, as amended.

Although the Office Action appears to allege with respect to claim 2 that Garnett et al. teaches the partially overlapping arrangement of computer stacks now recited in claim 1, as amended, the Office Action does not state where in Garnett et al. such a teaching may be found. Applicants have reviewed the text and figures of Garnett et al and can find no such disclosure.

Throughout the Office Action the Examiner incorrectly refers to Garnett et al.'s reference numerals 53 and 55 as first and second stacks of computers. Garnett et al. identifies reference numerals 53 and 55 as two sides of a chassis portion 49 of a shelf enclosure 47 that houses information processing cartridges 43. (¶¶ 36 and 37). Hence, Applicants respectfully submit that the Examiner may have misunderstood Garnett et al.

Applicants can find nothing in Garnett et al. that teaches or suggests arranging first and second stacks of information cartridges 43 such that back sides of the stacks partially overlap, an exposed portion of the first stack faces a first cooling plenum, and an exposed portion of the second stack faces a second cooling plenum. In particular, Garnett et al. describes information cartridges 43 in Figure 2, for example, as arranged side-by-side. (Garnett et al., ¶30)

In remarks with respect to Claim 12, the Office Action states that “Garnett et al. teaches the computer rack is configured to hold the first and second stack of computers 53, 55, except such that an overlapping portion of the first stack of computers faces an overlapping portion of the second stack of computers and an exposed portion of the first stack of computers faces the first cooling plenum and an exposed portion of the second stack of computers faces the second cooling plenum.” (Office Action, page 5, emphasis added) This statement contradicts the Office Action's unsupported assertions with respect to claim 2. Here, the Office Action apparently acknowledges that Garnett et al. does not teach or suggest an overlapping arrangement of computer stacks as recited in claim 1, as amended. The Office Action has not identified the partially overlapping arrangement of computer stacks now recited in claim 1, as amended, in any other reference either, and thus fails to satisfy the requirement of MPEP §2143.03 cited above for a *prima facie* case of obviousness.

The Office Action states that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the stack arrangement as taught by Garnett et al. with an overlapping arrangement, as an alternate of allowing air to flow to between the first and second stacks of computers and the cooling plenum.” (Office Action, page 5) To establish a *prima facie* case of obviousness there must also be “some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” See MPEP §2143 Basic Requirements of a *Prima Facie* Case of Obviousness. The Office Action does not cite any suggestion or motivation in the prior art to modify the computer system disclosed by Garnett et al. to provide the computer system of claim 1, as amended. Hence, the Office Action also fails to satisfy this requirement for a *prima facie* case of obviousness.

Claims 3-9, directly or indirectly dependent on Claim 1, distinguish over Garnett et al. for at least the reasons that Claim 1, as amended, distinguishes over Garnett et al. Hence, Applicants respectfully request that the Examiner withdraw the rejection of Claims 1 and 3-9 under 35 U.S.C. § 103(a).

#### **Claims 10 and 11**

Claim 10, as amended, distinguishes over Garnett et al. at least by reciting a computer system comprising a computer rack “configured to hold the first stack of computers such that a partially overlapping portion of the first stack of computers faces a partially overlapping portion of the second stack of computers and an exposed portion of the first stack of computers faces the first cooling plenum and an exposed portion of the second stack of computers faces the second cooling plenum.” As demonstrated above, Garnett et al. does not teach or suggest a computer rack configured to hold first and second stacks of computers in the partially overlapping arrangement recited in Claim 10, as amended.

Claim 11, dependent on Claim 10, distinguishes over Garnett et al. for at least the reasons that Claim 10, as amended, distinguishes over Garnett et al. Hence, Applicants respectfully request that the Examiner withdraw the rejection of Claims 10 and 11 under 35 U.S.C. § 103(a).

#### **Claims 13-15**

Claim 13 distinguishes over Garnett et al. at least by reciting a method comprising “providing a first and a second computer in a partial back-to-back relationship in the computer rack

such that an overlapping portion of the back of the first computer faces an overlapping portion of the back of the second computer.” As demonstrated above, Garnett et al. does not teach or suggest positioning computers in the partial back-to-back relationship recited in Claim 13.

Claims 14 and 15, dependent on Claim 13, distinguish over Garnett et al. for at least the reasons that Claim 13 distinguishes over Garnett et al. Hence, Applicants respectfully request that the Examiner withdraw the rejection of Claims 13-15 under 35 U.S.C. § 103(a).

#### **Claims 16-20**

Claim 16 distinguishes over Garnett et al. by reciting a computer system comprising “a support structure configured to support a first stack of computers and a second stack of computers in an offset back-to-back configuration.” With respect to claim 16, the Office Action states only that “Garnett et al. teaches a support structure configured to support a first stack of computers 53 and a second stack of computers 55 in a back-to-back (side-side-side) configuration.” The Examiner does not allege that Garnett et al. discloses the “offset back-to-back configuration” recited in claim 16, and Applicants can find no such disclosure. Information cartridges 43 shown in Garnett et al.’s Figures 2 and 3A, for example, are not arranged in such an offset back-to-back configuration.

Claims 17-20, directly or indirectly dependent on claim 16, distinguish over Garnett et al. for at least the reasons that claim 16 distinguishes over Garnett et al. Hence, Applicants respectfully request that the Examiner withdraw the rejection of Claims 16-20 under 35 U.S.C. § 103(a).

#### **New Claim 21**

New claim 21 distinguishes over Garnett et al. at least by reciting a computer system comprising a computer rack, first and second stacks of computers, and first and second cooling plenums, in which “the first cooling plenum is defined by an exposed portion of the back of the first stack, a first side of the second stack, and the computer rack; and the second cooling plenum is defined by an exposed portion of the back of the second stack, a first side of the first stack, and the

computer rack.” Garnett et al.’s cooling plenum 66, cited by the Examiner, is not defined in this manner.

**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **443452001800**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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